



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,589	10/18/2000	Lirio Quintero	154-12786-US-CIP	5046
	7590 03/30/2004		EXAMINER METZMAIER, DANIEL S	
Paula D. Morris The Morris Law Firm, P.C. 10260 Westheimer, Suite 360 Houston, TX 77042-3110			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 03/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,589

Applicant(s)

QUINTERO, LIRIO

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/22/2003 & 10/24/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 25, 29-34, 37-46, 49, 50 and 53-194 is/are pending in the application.
- 4a) Of the above claim(s) 37-42 and 53-79 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 113-193 is/are allowed.
- 6) ☒ Claim(s) 1-14, 25, 29-34, 43-46, 49, 50, 80-112 and 194 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-15, 25, 29-34, 37-42, 43-46, 49-50, 53-79 and 80-194 are pending.

Claims 37-42 and 53-79 have been withdrawn as directed to non-elected inventions.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14, 25, 29-34, 37-42, 43-46, 49-50, 53-79, 80-112 and 194 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of the claims are indefinite because it is unclear whether the claims require "the polymerizable silicate solution" by the phrase "thereby encapsulating said droplets" or whether said later phrase merely further modifies the what for the media is adapted.

Claims 34, 46, 86-88, 104, 108, and 180-182 are indefinite. The scopes of the claims are indefinite since the claims employ open language when defining subgenus or species in an alternative grouping. See for example, claims 86-88, 104, 108, and 180-182, employs "said polyoxyethylene alcohols comprise" where claim 1 employs Markush language defining "emulsifiers selected from the group consisting of". Also claims 34 and 46 employ the improper language "selected from the group consisting essentially of". It is unclear what are the metes and bounds of the claimed subject matter sought to be patented. The alternative groupings should use closed language, ie., "selected from the group consisting of".

Art Unit: 1712

Applicant should review all of the ~~194~~ claims under consideration for the issues raised in this rejection, address each issue and/or take appropriate action.

Claim 194 is indefinite since it is unclear what means applicants intend for each of the means plus function recitations of the claim. The metes and bounds of the means set forth at pages 5-8, lines 1 to 13; and pages 8 to 9, lines 4 to 18; is unclear. Applicant has not specifically set forth the scope of said means rendering the metes and bounds of the claims indefinite.

3. Regarding the prior art below the claims are interpreted as not requiring said silicate solution. Claims are given their broadest reasonable interpretation. See MPEP 2111.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-14, 25, 29, 80-99 and 194 are rejected under 35 U.S.C. 102(b) as being anticipated by Otrhalek et al, US 4,032,466. Otrhalek et al (example 3 and claims, particularly claim 8) discloses compositions reading on the claims. Said compositions (all parts are by weight – see column 8, lines 59-62) comprise 12 parts alpha-alkyl-omega-hydroxy poly(oxyethylene) with an average of 9 moles of oxyethylene, 4 parts of linear alkyl sulfonic acid, denoted as Calsoft LAS-99, and 30 parts of 37% hydrochloric acid. The nonionic (12) to anionic (4) ratio equates to 75/25, which reads on the

Art Unit: 1712

claimed ratios. The pH would have been inherent to the 30 parts of the 37% hydrochloric acid. Typical pH of a 0.1N HCl solution is pH = 0.1. 0.1N equates to about a 3.6% hydrochloric acid solution. The concentration of the hydrochloric acid media of Otrhalek et al is an order of magnitude greater and would have been expected to have a pH of 1 or less.

6. Claims 1-9, 25, 29-34, 80-88 and 95-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Lambremont et al, US 5,707,952. Lambremont et al (column 2, lines 38 et seq; example 1, table bridging columns 9 and 10; and claims, particularly claim 1) disclose aqueous acidic cleaners, which are in the form of microemulsions containing up to 2% by weight of water-insoluble hydrocarbon. Patentees claimed pH for the compositions may range from about 1 to about 4. Said range reads on the instantly claimed about 1 or less.

7. Claims 1-6, 25 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al, US 5,129,460. See examples, tables and claims.

8. Claim 194 is rejected under 35 U.S.C. 102(b) as being anticipated by Noonan et al, US 5,076,938. See examples, tables and claims.

Allowable Subject Matter

9. Claims 15 and 113-193 are allowed.

10. Claims 43-46, 49-50, and 100-112 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed October 24, 2003 have been fully considered but they are not persuasive.

12. Applicants (pages 22 and 23) request the withdrawal of the rejections under 35 USC 112, second paragraph, in view of the amendments. The remaining issues appear above. Applicant should review all the claims numbering in excess of 100 and remove any related issues raised.

13. Applicants (pages 22 and 23) assert the examiner has not pointed to any teaching or suggestion in the Otrhalek reference that the compositions therein have "an HLB effective to produce an emulsion comprising free hydrocarbon droplets". Said characterization is inherent and/or at least implicit to the cleaning compositions, which would require at least some emulsification of the hydrocarbon. The ordinary skilled artisan need look no further than the definition of detergent to recognize that detergents are well known and accepted to emulsify organic materials. Attention is directed to **Hawley's Condensed Chemical Dictionary, 11th Edition**, pp. 355, detergent. It is clear that said compositions would inherently produce emulsions comprising at least some free hydrocarbon droplets as claimed.

14. Applicants (page 23) assert that to establish a rejection under anticipation, each element must be taught or inherent. The claimed compositions are indistinct from those disclosed in the prior art except for applicant's functional language. Since the compositions appear to be the same and the properties of a compound or composition are generally inseparable from said compound or compositions, it logically follows that

the compositions would be anticipated by the prior art of record as set forth in the above rejections.

Applicants further assert the use of transitional language "consisting essentially of" distinguishes the prior art to Otrhalek et al since said reference is directed to a cleaner and includes a flocculating agent. This has not been deemed persuasive since applicants claims further claim the compositions must be adapted to polymerization and encapsulation but do not define the encapsulant or polymerization reaction. Applicant has the burden of showing said language distinguishes the instant claims. See MPEP 2111.03. "For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to 'comprising.' See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355."

15. The only apparent requirement for the media to be "adapted to initiate acid reactive polymerization of a polymerizable silicate solution thereby encapsulating said droplets" is that the compositions have the ability to emulsify employing the claimed emulsifiers and that said emulsifier compositions are acidic. The claims do not require the polymerizable silicate solution and the polymerizable silicate solution would have been expected to encapsulate in the presence of an acid. Said acid is present in the references relied upon.

16. Applicants (page 25) assert the further ingredients of the thickeners in Lambremont are excluded by the "consisting essentially of" language. Applicants have not shown or addressed how or why said thickening agent of the Lambremont reference

Art Unit: 1712

would materially effect the "acid reactive polymerization of a polymerizable silicate solution thereby encapsulating said droplets". Applicant's arguments are furthermore, unpersuasive in view of the facts disclosed in the Lambremont reference that the compositions are shear thinning, i.e., flow under shear stress.

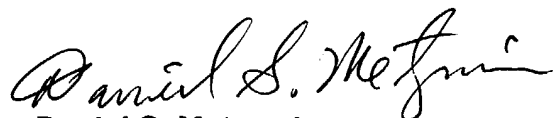
17. Applicants remaining arguments for the remaining prior art rejections as addressed above regarding the Otrhalek et al reference. Said arguments have been addressed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel S. Metzmaier
Primary Examiner
Art Unit 1712